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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,260	04/08/2004	Sarah Bruce Snyder	6298-456	8627
757	7590	12/13/2005	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			BUNIN, ANDREW M	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/821,260	<b>Applicant(s)</b> SNYDER ET AL.	
	<b>Examiner</b> Andrew M. Bunin	<b>Art Unit</b> 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 41-58 is/are pending in the application.  
4a) Of the above claim(s) 9-21 and 47-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 41-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 9-21 and 47-58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/8/05.

Applicant's election without traverse of claims 1-8 and 41-46 in the reply filed on 9/12/05 is acknowledged.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

Claim 5 contains the trademark/trade name PermaStat. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the type of material within the plastic and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6-8, and 41-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Rupprecht et al. (Medical Device & Diagnostic Industry Magazine- January 1999).

Rupprecht et al. discloses an antistatic holding chamber comprising a plastic material having a surface resistivity of between about 10E10 and about 10E12 ohm/sq.

Art Unit: 3743

Rupprecht et al. states how polycarbonate thermoplastics are used with "equipment housings and reservoirs" in medical components which anticipates an antistatic holding chamber (page 7 under the heading Thermoplastics in Common Conductive Compounds). In addition, Rupprecht et al. includes a table that teaches a plastic material having a surface resistivity  $1E10$ - $1E12$  ohm/sq. This range meets the objective of the instant application's surface resistivity. Rupprecht et al. continue to disclose the plastic material comprising a polypropylene material (Table I). Rupprecht et al. also disclose the material as being either polypropylene, polycarbonate, polystyrene, nylon, acrylonitrile butadiene styrene, high density polyethylene, acetal, or polybutylene terephthalate (Table I). Rupprecht et al. teach at least a portion of the holding chamber is see-through. Rupprecht et al. states, "thermoplastic compounds retain transparency while exhibiting static-control properties" (page 9, 2<sup>nd</sup> paragraph under section Features of Conductive Thermoplastics). As for claim 8, Rupprecht et al. continues to meet the range of a plastic material having a surface resistivity between  $10E10$  and about  $10E11$  ohm/sq. as shown in the bottom of Table I.

Furthermore, Rupprecht et al anticipate claims 41-46. Rupprecht et al. disclose an antistatic component comprising a see-through material having a surface resistivity of less than about  $10E12$  ohm/sq (bottom of Table I). In addition, Rupprecht et al. states, "thermoplastic compounds retain transparency while exhibiting static-control properties" (page 9, 2<sup>nd</sup> paragraph under section Features of Conductive Thermoplastics).

Rupprecht et al. states how polycarbonate thermoplastics are used with "equipment housings and reservoirs" in medical components which anticipates a component having

Art Unit: 3743

a holding chamber (page 7 under the heading Thermoplastics in Common Conductive Compounds). As stated above, the plastic having a surface resistivity between about 10E6 and 10E12 ohm/sq, 10E10 and 10E12 ohm/sq, and means for providing a surface resistivity of between about 10E10 and 10E12 ohm/sq is anticipated in Table I of Rupprecht et al. Lastly, Rupprecht et al. discloses the antistatic component as being utilized as a holding chamber or other parts of a respirator or nebulizer similar to the instant application. Rupprecht et al. states how the thermoplastic polysulfone may be used with respirators or nebulizers on page 7 (Thermoplastics in Common Conductive Compounds).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rupprecht et al. in view of Engelbreth et al. (US 6345617). Rupprecht et al. discloses everything except the specific features of the medication delivery apparatus that includes the antistatic holding chamber. However, Engelbreth et al. discloses a holding chamber 24 having an input end 46 and an output end 48, and further comprising a backpiece 527 separate from the holding chamber 24 and comprising an elastomeric material (column 8, lines 41-45) wherein the backpiece 527 is connected to an input end

of the holding chamber (Figure 17). In addition, the backpiece 527 comprises an opening 529 formed therethrough, this opening 529 is shaped and adapted to receive a portion of a pressurized metered dose inhaler (Figure 17). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the device of Engelbreth et al. to include the plastic taught by Rupprecht et al. in order to control static within inhalers for proper dosage (MD&DI page 10, 1<sup>st</sup> bullet under Applications section).

Claims 1, 2, 5-8, and 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rupprecht et al. in view of the applicant's prior art. Applicant has admitted in the specification that the PermaStat compounds are well known in the art specifically available from the RTP Company. Therefore, it is noted that applicant's specification does not set forth this feature, as unexpectedly providing any new result or unexpectedly solving any new problem in the art over the prior art. Accordingly, the examiner considers the selection of such to be a mere obvious matter of design choice and as such does not patentably distinguish the claims over the prior art, barring a convincing showing of evidence to the contrary. In addition, applicant has shown through the IDS ("PermaStat Compounds"- RTP Company) that the PermaStat compounds include the characteristic of a consistent surface resistivity of 1E10 to 1E11 ohms/sq. as well as retain transparency. Therefore, the prior art of PermaStat anticipates the claimed subject matter in relation to the antistatic plastic.


**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US 2004/0094148, US 6435176, US 3896101, and US 6293279

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew M. Bunin whose telephone number is (571)272-4801. The examiner can normally be reached on Monday - Friday, 8 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (571)272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
AMB  
11/21/05

  
Henry Bennett  
Supervisory Patent Examiner  
Exam 3/00